

## **REMARKS**

Applicants respectfully request reconsideration of the present application. Claims 11-21 are currently pending in the present application.

### **ALLOWABLE SUBJECT MATTER**

Applicants appreciate and thank the Examiner for the indication of allowable subject matter contained in claims 11-21, including independent claim 11.

### **REJECTIONS UNDER 35 U.S.C. §112, 1<sup>ST</sup> PARAGRAPH**

Claims 11-21 stand rejected under 35 U.S.C. §112, 1<sup>ST</sup> paragraph as lacking enablement.

Initially, the Examiner alleges that the specification fails to provide support for “an uncured electrically non-conductive thermoplastic to bond with an electrically conductive elastomer” (see outstanding Office Action page 2, paragraph 4).

With regard to the above aspect of the rejection, Applicants have amended claims 11-13, 15, 18 and 21 taking into account the Examiner’s suggestion, and assert that all such amendments to claims 11-13, 15, 18 and 21 have been made for no other reason than to fulfill the requirement under 35 U.S.C. § 112 1<sup>ST</sup> Paragraph.

The Examiner further alleges that the specification does not reasonably provide enablement “for bonding an electrically conductive elastomer with the

electrically non-conductive thermoplastic" (see outstanding Office Action page 2, paragraph 4).

With regard to the aspect of the rejection immediately above, Applicants respectfully traverse this rejection.

35 U.S.C. §112, first paragraph recites:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

The enablement requirement refers to the requirement of 35 U.S.C. §112, first paragraph that the specification describe how to make and use the invention. One skilled in the art must be enabled to make and use the claimed invention of the particular application in question.

Initially, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not indicate lack of enablement with respect to the limitation in question. Limitations must be analyzed for both enablement and description using their separate and distinct criteria. See M.P.E.P. §2164.

Further, when subject matter is not described in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation.

A test of enablement requires a determination of whether that disclosure, when filed, contains sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. See M.P.E.P. 2164.01.

When analyzing claims for meeting the enablement requirement with respect to 35 U.S.C. §112, first paragraph, the burden is initially on the Examiner to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ 2d 1510, 1513 (Fed. Cir. 19993) (the Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented and must be taken as being in compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, unless there is a reasonable doubt the objective truth of the statements contained therein which must be relied on for enabling support. As stated by the court,

"It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and the back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the Applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439F2d at 224, 169 USPQ at 370.

The minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement. The language should focus on those factors, reasons and evidence that lead the Examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of the fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art did not develop without undue experimentation. In such a case, the Examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. See M.P.E.P. §2164.06(a). References should be supplied if possible to support a *prima facie* case of lack of enablement, although not always required. *In re Marzocchi*. However, **specific technical reasons are always required.**

The first Office Action on the merits should present the best case with all the relevant reasons, issues and evidence so that all such rejections can be withdrawn if the Applicant provides appropriate convincing arguments and/or evidence in the rebuttal.

Applicants respectfully assert that the Examiner has not presented all the relevant reasons, issues and evidence, nor provided a specific

**technical reasons required** to establish a *prima facie* case to support the Examiner's rejection of claims 8 and 17. Applicants further assert that the bonding of an electrically conductive elastomer with the electrically non-conductive thermoplastic is sufficiently supported in the specification. See page 11, lines 17-20, page 12, lines 3-10, page 14, lines 12-15, and page 14 line 20-page 15 line 3 of the specification.

Thus, Applicants respectfully assert that claims 11-21 satisfy the statutory requirements under 35 U.S.C. § 112 1<sup>ST</sup> Paragraph.

As such, Applicants respectfully request that this rejection be withdrawn.

**REJECTIONS UNDER 35 U.S.C. §112, 2<sup>ND</sup> PARAGRAPH**

Claims 11-21 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which the Applicant regards as the invention.

Applicants respectfully traverse this rejection.

Applicants have amended claims 11-13, 15, 18 and 21 taking into account the Examiner's suggestions. Applicants further assert that all such amendments to claims 11-13, 15, 18 and 21 have not been made to overcome any art grounds of rejection and have been made for no other reason than to fulfill the statutory requirements under 35 U.S.C. § 112 2<sup>ND</sup> Paragraph.

Further, in view of the amendments to claims 11-13, 15, 18 and 21, Applicants respectfully assert that claims 11-21 now satisfy the statutory requirements under 35 U.S.C. § 112 2<sup>ND</sup> Paragraph.

As such, Applicants respectfully request that this rejection be withdrawn.

## **CONCLUSION**

In view of above remarks, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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